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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/401,595	09/22/1999	KILIAN PETER HOCHREIN	FA/221	4868

7590 01/25/2005

GARY A SAMUELS
W L GORE & ASSOCIATES INC
551 PAPER MILL ROAD
P O BOX 9206
NEWARK, DE 197149206

EXAMINER

JUSKA, CHERYL ANN

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/401,595

Applicant(s)

HOCHREIN ET AL.

Examiner

Cheryl Juska

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) 20 and 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Response to Amendment

2. Applicant's amendment filed December 31, 2004, has been entered. New claims 19-21 have been added as requested. The pending claims are 10-21.

Election/Restrictions

3. Newly submitted claims 20 and 21 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Said claims are drawn to a method of treating biodegradable matter in aerobic composting, while the invention originally claimed is drawn to a cover for the aerobic treatment of biodegradable material. Since the originally claimed invention is a product and said new claims are method claims, the inventions are distinct and restriction is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution

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on the merits. Accordingly, claims 20 and 21 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-12 and 15-17 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, for the reasons of record.

6. Claim 19 is indefinite for the use of the phrase “adapted for.” It is unclear what applicant intends to encompass by this limitation. How is the laminate “adapted?” Is it merely employed as a cover or is it specially treated (e.g., coated, embossed, heat treated, etc.) to render it suitable for the intended use?

Claim Rejections - 35 USC § 102/103

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 10, 11, and 15-17 stand rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over JP 06-047363 issued to Chikamori, for the reasons of record.

10. Claim 19 is rejected under 35 USC 102(b) as being anticipated by, or in the alternative, under 35 USC 103(a) as being unpatentable over JP 06-047363 issued to Chikamori.

New independent claim 19 differs from independent claim 10 first by the addition of a recitation that the PTFE is expanded PTFE exhibiting a node and fibril structure. This limitation is insufficient to overcome the Chikamori reference since said reference teaches the preferred porous film is “extension porosity PTFE” (section [0005] of the Japanese translation). The examiner equivalates this teaching to expanded PTFE which inherently has nodes and fibrils.

Secondly, claim 19 differs from claim 10 by a recitation that the invention “is adapted for the aerobic treatment of biodegradable material.” This recitation is also insufficient to overcome the Chikamori rejection since said recitation is unclear as described above and since the Chikamori invention is capable of aerobic treatment due to its like structure and chemistry as applicant’s invention. It has been held that the recitation that an element is “adapted to” perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138. Therefore, claim 19 is rejected.

Claim Rejections - 35 USC § 103

11. Claim 12 stands rejected under 35 USC 103(a) as being unpatentable over the cited

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Chikamori patent, for the reasons of record.

Response to Arguments

12. Applicant's arguments filed with the amendment of December 31, 2004, have been fully considered but they are not persuasive.

13. Applicant traverses the 112, 2nd rejection by asserting the recitation to a porous PTFE layer having the claimed average pore size adhered to the recited fabric component is sufficient definite and clear to define the scope of the invention. The examiner respectfully disagrees. The claims encompass all prior art and future covers that have the claimed properties, but applicant has only invented one particular cover. "Reciting the physical and chemical characteristics of the claimed product will not suffice where it is not certain that a sufficient number of characteristics have been recited that the claim reads only on the particular compound which applicant has invented." *Ex parte Siddiqui*, 156 USPQ 426, *Ex parte Davission et al.*, 133 USPQ 400, *Ex parte Fox*, 128 USPQ 157. In the instant case, the claims are not sufficiently described in terms of structure and/or composition to clearly identify the actual invention.

14. To illustrate this point and in rebuttal of the prior art rejection, applicant is directed to the 102/103 rejection. Specifically, while the Chikamori invention meets the structural and chemical features of the claimed invention, applicant continues to assert that it does not have the same properties or that it is able to function as an aerobic cover. If this assertion is true, than applicant has neglected to claim the structural and/or chemical features of the invention which produce said properties and applicant's claims are indefinite. Otherwise, as asserted by the examiner, the

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Chikamori invention meets the chemical and structural features and, as such, must possess the same properties since like materials cannot have mutually exclusive properties.

15. Applicant also argues the Chikamori rejection by asserting that Chikamori failed to recognize and failed to claim applicant's unique cover and its properties for aerobic decomposition. In response, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). In other words, the prior art need not recognize applicant's intended utility or properties that are inherent to a material or product.

16. Additionally, it is reiterated that applicant has not specifically pointed out how the structure or chemistry of Chikamori is different from the claimed invention. Furthermore, it is reiterated the alleged difference in function is merely argumentative of intended use. If the structure of Chikamori is equivalent to the presently claimed invention, then it is reasonable to presume that the prior art structure is capable of performing the same function as applicant's invention. Applicant has still not provided evidence to the contrary. Therefore, applicant's arguments are found unpersuasive and the above 102/103 and 103 rejections are hereby maintained.

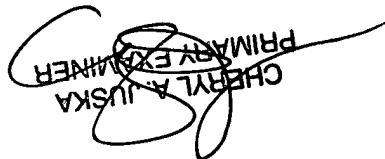
Conclusion

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cheryl Juska whose telephone number is 571-272-1477. The examiner can normally be reached on Monday-Friday 10am-6pm. If attempts to reach the

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examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached at 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


CHERYL A. JUSKA
PRIMARY EXAMINER